

REMARKS:

Claims 1 and 3-9 have been rejected under 35 U.S.C. §103(a) as being unpatentable over applicant's admitted prior art (AAPA) in view of Loshkajian (2005/0000979) and Franks (6,732,899). Claims 10-12 have been rejected under 35 U.S.C. §103(a) as being unpatentable over applicant's admitted prior art (AAPA) in view of Loshkajian (2005/0000979) and Franks (6,732,899).

The previous claims 1 and 3-10 were rejected under 35 U.S.C. §103, which provides in pertinent part:

"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

The invention to which the statute refers is defined by the claim language of the application when the claims of an application, rather than a patent, are under consideration. Thus, unless the subject matter, as a whole, defined by the claim's language, would have been "obvious", the claim is patentable.

The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) set forth what has become known as "the Graham factors" for determining whether claimed subject matter passes muster

under section 103; requiring that "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the art to be resolved." *Id.* at 17. The Court also expected that other factors, or "secondary considerations," could very well be relevant to the obviousness inquiry, and should thus also be accorded consideration when present. *Id.* at 18. Obviousness analysis begins with these factual findings. *Id.*

More recently, in deciding *KSR International Co. v. Teleflex, Inc.*, 550 U.S. ____ (2007) the Court rejected rigid adherence to the "teaching, suggestion, or motivation" test for obviousness adopted in recent years by the Court of Appeals for the Federal Circuit and reaffirmed the *Graham* factors as consistent with its "expansive and flexible approach." In doing so, the Court expressly rejected the application of "preventative rules that deny factfinders recourse to common sense." *Id.* at _____. The Court however reaffirmed the long-established requirement that factual inquiries must reveal that there would have been a reason to combine old elements before a legal case of obviousness is established under section 103 and the reason should be articulated in the record. *Id.* at _____. The Guidelines under *KSR* (Docket No. PTO-P-2007-0031) reiterate these requirements.

In this application, the previous claim 1 was rejected over known art in view of U.S. Patent Application Publication No. 2005/0000979 of Loshkajian ("Loshkajian") and U.S. Patent No. 6,732,899 to Franks ("Franks"). Loshkajian discloses a board 10 for displaying a plurality of PEZ® tablet dispensers 12 each

having handle 40 operable to dispense candy tablet 36 from housing 16 (Paragraphs [0021]-[0025]). Board 10 includes a plurality of spaced apart apertures 14 each for receiving a press fit portion 60 of clip 50 adapted to grip one of dispensers 12 (Paragraph [0028]). Since dispensers 12 are available in a variety of appealing handle designs, board 10 is provided for children to display dispensers they have collected. (Paragraphs [0008] and [0026]). Clip 50 retains a dispenser on the board for display while also permitting removal from the board as desired (Paragraph [0026]).

Franks discloses a system 10 for dispensing plastic fasteners from a supply of stock 11 (Col. 4, lines 32-37). Franks system 10 includes a workstation W supporting mounting stand 17 limiting the displacement of fastener dispenser 15 and supporting both counterbalance 19 and a reel of plastic fasteners 13 (Col. 4, lines 62-67).

One of ordinary skill, the Examiner asserts, would have combined known elements of the previous claim 1 with the step of affixing an item to a board with an elastic staple, as taught by Franks, and Loshkajian's step of stabilizing the item with a fixture, to produce applicant's invention (Office Action mailed 7/25/2007, Page 2). The reason one would have done this, the Examiner maintains, would have been to secure products onto a display board (Id. at page 3). This conclusion however is not the product of obviousness analysis consistent with *Graham* and *KSR*, which commend practitioners to analyze the prior art and articulate a rational underpinning supporting any obviousness conclusion.

Loshkajian in fact discloses a method of displaying items on a board and Franks discloses a device for stapling items to a board. The skilled artisan would have had no apparent reason to combine elements of Franks and Loshkajian. Affixing Loshkajian's dispensers with an elastic staple would defeat Loshkajian's goal of enabling a child to remove and play with its dispensers. Franks, on the other hand, is not at all concerned with using a fixture to stabilize an item. To say that one would have combined the references to secure products onto a display board explains no motive; both references disclose a method for securing a product on a display board. Merely breaking applicant's method into its component parts and then finding each of the parts in the prior art as the Examiner has done does not complete the obviousness analysis. Whether or not one of ordinary skill could have made the combination, the obviousness inquiry is supposed to focus on what, without any knowledge of the claimed invention, one would have done. The Examiner did not articulate a rational underpinning for its obviousness conclusions in accordance with Graham and KSR.

Claim 1 has nevertheless been amended to describe a method that was, as a whole, neither known nor one that the ordinarily skilled artisan would have produced by combining prior art teachings. The method includes boarding an item by feeding a board onto a rotatable table and lowering a fixture over the board. An item is placed on the board in the fixture and stabilized. An elastic staple affixes the item to the board while it is stabilized with the fixture and the fixture is removed from the board. The board is removed from the table with the item affixed. While admittedly, it was known at the time of the applicant's invention to use a table for boarding an

item and to affix an item to a board with an elastic staple, it was not previously known to board an item using a fixture in the specific way applicant has claimed.

Claim 3, which has not been amended, depends from claim 1 and describes the step of feeding a board as including automatically placing a board on the table. Whether or not this step by itself is old, it is new in combination with the method steps of claim 1 in view of the prior art, and no basis for concluding it would have been obvious has been articulated. The same can be said of claims 4-9 of the application. These claims are therefore allowable in view of the prior art of record in this case.

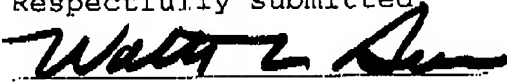
The previous claim 10 was also rejected under section 103 over known prior art in view of Loshkajian and Franks. The Examiner again simply asserts obviousness without explaining why the ordinarily skilled artisan would have combined prior art elements to produce applicant's invention as a whole. Notwithstanding that inadequacy of explanation, claim 10 has been amended to describe a method that includes feeding a board onto a rotatable table, placing an item on a fixture and lowering the fixture over the board. This item is stabilized on the board with the fixture and attached to the board with an elastic staple while the item is contiguous to the fixture. The method also includes the steps of raising the fixture from the table and removing the board from the table with the item thereto stapled. Such a method is neither known nor one that would have been obvious in view of known elements, Loshkajian and Franks. The claim is therefore in condition for allowance over the prior art of record.

New claim 21 describes applicant's method with still more particularity and is therefore also believed to be patentable. Examination of this new claim as a whole in view of the prior art is respectfully requested, as the claim language describes a method of packaging that is not disclosed or suggested by the prior art of record.

Based on the changes made to independent claims 1 and 10, applicant believes that his method is patentably distinct over the prior art references of applicant's admitted prior art and the prior art patent of Franks and the publication of Loshkajian whether such art is considered under §102 or in combination under §103. Accordingly, claim allowance is earnestly solicited at the Examiner's earliest convenience.

Respectfully submitted,

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I hereby certify that this correspondence is being facsimile transmitted to the Director of the United States Patent and Trademark Office, Mail Stop AF, Group Art Unit 3726, Attention: Examiner John C. Hong (13 pages including cover letter) to Fax No. (571)273-8300 on this 25th day of October, 2007.


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